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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,885	09/23/2004	Tatsukazu Kimura	CU-3914 RJS	8117

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LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO, IL 60604

EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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07/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/508,885	Applicant(s) KIMURA ET AL.	
	Examiner Steven D. Maki	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) **Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 808 (JP 08-112808) in view of Sucech et al (US 5,683,635), Hauber et al (US 6,878,321), Birdsey (US 1,514,827) and Ferguson (US 5,799,458).**

Japan 808, Sucech et al, Hauber et al, Birdsey and Ferguson are applied as in paragraph 4 of the last office action dated 1-9-08 (paragraph 4 of the last office action is incorporated herein by reference).

According to the partial oral translation of paragraph 15 of Japan 808, Japan 808 states: "The length of the application roller 14 is smaller than the width of the original paper and between the edges of the application roller 14 and original paper A, a non-extended part 20 not shown in the drawing is formed. The width of the non-extended part 20 is generally preferred to be from 10 mm to 50 mm". See page 4 of office action dated 1-9-08.

Applicant states that Japan 808 discloses at paragraph 15 "it is generally preferable that the width of the non-spread portion 20 is 10 mm through 50 mm". See page 6 of response filed 4-11-08.

Applicant argues that the width of the non-spread portion changes from 10 mm to 50 mm. Examiner disagrees. One of ordinary skill in the art would not have understood paragraph 15 of Japan 808 as describing the non-spread portion 20 as having an exact

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initial lower limit width of 10 mm and an exact final upper limit width of 50 mm. It is noted that applicant fails to direct attention to any part of Japan 808 which describes the distance (e.g. one meter) from the spreading roller at which the alleged final upper limit width is to be determined. Contrary to applicant's arguments, one of ordinary skill in the art would have understood the range of 10-50 mm in paragraph as being descriptive of "a width" of the non-spread portion 20 since (1) Japan 808 describes the non-spread portion 20 with reference to the edge of the spreading roll and the edge of the paper (instead of an initial location and a downstream location) and (2) the width between the edge of the spreading roll and the edge of the paper is a fixed width. See for example paragraph 8 of machine translation of Japan 808 and above noted partial oral translation by USPTO translator. In other words, examiner maintains that Japan 808 teaches forming a non-spread portion such it has a width falling in the range of 10 to 50 mm.

Applicant's arguments regarding the range 98% through 108% are not persuasive since they are based on the incorrect factual finding that Japan 808 describes 10 mm as being a lower limit at an initial location and 50 mm as being an upper limit at a downstream location.

With respect to "width of the non-spread portion is less than 10 mm", examiner maintains that it would have been obvious to one of ordinary skill in the art to provide the non-spread portion with a width of "less than 10 mm" such as 9.99 mm since (1) Japan 808 teaches forming non-spread portions extending from the ends of the spreading roll for obtaining a plaster board having high density edges (for preventing

dryout) and (2) Japan 808's disclosure of the non-spread portion having a width of 10 mm to 50 mm is merely a preferred teaching. As explained by the Federal Circuit, "...our case law does not require that a particular combination must be the preferred, or most desirable, combination described in the prior art in order to provide motivation for the current invention." In re Fulton 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Remarks

- 3) Applicant's arguments filed 4-11-08 have been fully considered but they are not persuasive.
- 4) No claim is allowed.
- 5) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

- 6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven D. Maki/
Primary Examiner, Art Unit 1791

Steven D. Maki
July 20, 2008